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Kerry Keehan

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the application of:

Christopher G.M. Ken and Abhijit
ACHARYA

Serial No.: 08/736,896

Filing Date: October 25, 1996

For: DETACHABLE MULTIDIAMETER
VASOOCCLUSIVE COIL

Examiner: W. LEWIS

Group Art Unit: 3731

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TC 3700 MAIL ROOM

REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231
Dear Sir:

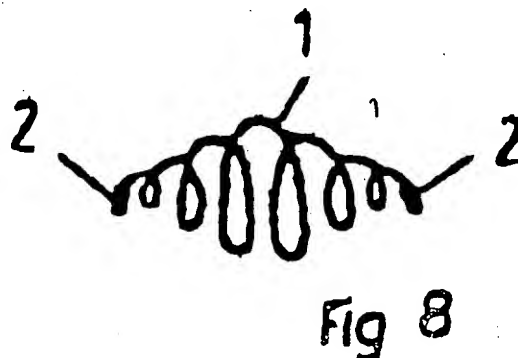
This Reply Brief is in response to the Examiner's Answer mailed May 25, 2000. This Reply Brief is submitted for the purpose of 1.) emphasizing one point central to the claimed invention and absent from the cited prior art and 2.) clarifying any potential confusion about the suggestion in the Examiner's Answer suggestion that the absence of an argument may be taken as some type of admission.

Structure of the Claim of Vasoocclusive Coil.

It's the responsibility of the PTO to examine a patent application based on the specific limitations found in the claims. Appellants completely agree with the Examiner that Figure 8 of the Heinke et al reference shows that the various twists of the coil spiral and get radially smaller

towards the ends of the coil. However, that obviously correct argument does not have much to do with the requirement in the claims at the “proximal end” and the “distal end” are positioned inwardly of the coil winding just adjacent those ends. Now, in this instance, the term “end” is used in its normally defined, dictionary-type sense. The “ends” of Figure 8, irrespective of the size of the coils mentioned in the Final Rejection, are not within the interior of that next adjacent turn when the coil is collapsed as the various Office Actions and Examiner’s Answer has suggested. The PTO has not provided a *prima facie* argument relating to those limitations. Here, the PTO has provided no explanation of why it would be obvious to reduce the position of the end to one that is inside the next adjacent helical turn.

To reiterate: the ends of the various coils shown in the German reference are not inside the curvature of the helical turn of the coil just adjacent. Figure 8 from the German reference, specifically mentioned in the Examiner’s Answer, is reproduced for clarity:



Note that the ends marked “2” extend downwardly (or in an apparently radial direction) beyond the radius of the next adjacent coil winding. It is this critical piece missing from the Final Office Action that renders the rejection fatally defective. The structure alleged in the Final Rejection simply isn’t to be found in German reference and conclusory statements to the contrary, and if it ain’t there, it ain’t there.

Reversal of the Final Rejection is appropriate on this basis.

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Admissions



The Examiner's Answer suggested "Applicant has fail to point as to why the combination is improper and should be treated as an admission that this feature is well known and established in the prior art."

Appellants disagree with the logic noted there. First of all, Appellants have argued that the combination is improper because of a failure to provide any reason based upon the interior teachings of the two references urging the combination of the specific technologies. Nevertheless, even if the argument had not been made, any failure to argue that the combination is improper has little or nothing to do with whether the feature found in the Mariant et al. reference is "well known and established in the prior art."

In summary, Applicants dispute that any such admission has been provided in this appeal.

SUMMARY

Reversal of the Final Rejection is appropriate and is requested.

Respectfully submitted,

Dated: June 29, 2000

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